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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/552,815	04/20/2000	Steven G. Goldstein	50N3483/1333	4648

24272 7590 12/16/2004

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EXAMINER

WALLERSON, MARK E

ART UNIT

PAPER NUMBER

2626

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/552,815

Applicant(s)

GOLDSTEIN ET AL.

Examiner

Mark E. Wallerson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-48, 51-61 and 66-69 is/are allowed.
- 6) ☐ Claim(s) 49, 50 and 62-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**Part III DETAILED ACTION**

*Notice to Applicant(s)*

1. This action is responsive to the following communications: amendment filed on **1/30/2004**.
2. This application has been reconsidered. Claims 1-69 are pending.
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371<sup>9</sup> of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 49 and 50, are rejected under 35 U.S.C. 102(e) as being anticipated by Enomoto.

With respect to claims 49 and 50, Enomoto discloses a system for transferring image data to a service provider (12), comprising an image source (20 or 21), and an image pump (which reads on computer 11) configured to receive the image data from the image source by a hard-wired connection (column 6, lines 23-32), and provide the image data to the service provider (column 6, lines 44-50), the image pump (11) being implemented separately from the image source (20 or 21).

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371<sup>6</sup> of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 62 and 64 are rejected under 35 U.S.C. 102(e) as being anticipated by Safai (U. S. 6,167,469).

With respect to claim 62 and 64, Safai discloses capturing image data by utilizing an image source (100); providing the image data to an image pump (figure 2) integral with the camera; converting the image data to a format compatible with the service provider (column 5, lines 28-62 and column 7, lines 14-50); attaching user defined instructions and customer account information (column 7, lines 32-50 and column 15, lines 16-27); transferring the image from the image pump to the service provider (column 2, lines 1-3); reviewing the order and providing services to the user (column 9, lines 30-45).

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7. Claims 63 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Safai in view of Enomoto.

With respect to claim 63, Safai differs from claim 63 in that he does not clearly disclose that the image source is a scanner. Enomoto discloses a scanner as an image source (20). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Safai by the teaching of Enomoto in order to vary the image sources.

With respect to claim 65, Safai discloses including customer account information (column 15, lines 17-27). Safai differs from claim 65 in that he does not disclose determining if the image data and customer information have errors, and requesting the image pump to re-transmit the image data and customer information if errors are detected. Enomoto discloses determining if the image data and customer information have errors (column 7, lines 4-8), and requesting the image pump to re-transmit the image data and customer information if errors are detected (column 7, lines 4-8). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Safai by the teaching of Enomoto in order to improve the image system.

***Allowable Subject Matter***

8. Claims 1-48, 51-61, and 66-69 are allowed.

***Response to Arguments***

9. Applicant's arguments filed 10/4/04 have been fully considered but they are not persuasive. With respect to claims 62-65, Applicant submits that *Safai* does not disclose

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reviewing the image data and customer account information for accuracy and format errors. The Examiner disagrees.

*Safai* discloses checking the user address for format errors (column 9, lines 30-45).

With respect to Applicant's arguments pertaining to claims 49 and 50, Enomoto clearly discloses the claimed subject as discussed by the Examiner in paragraph 4 above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (703) 305-8581. The examiner can normally be reached on Monday-Friday - 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark E. Wallerson  
Primary Examiner  
Art Unit 2626

MARK WALLERSON  
PRIMARY EXAMINER

